

U.S. Application No. 09/980,158
Docket No. 80-20693958 (formerly 6208-031)
Reply to the Final Office Action of January 17, 2007

REMARKS

Applicants respectfully request reconsideration of the above referenced application in light of the remarks that follow. Claims 1-21 are now pending in this application.

In the Final Office Action dated January 17, 2007 (the "Final Office Action"), the Examiner rejected claims 1 and 3-20 under 35 U.S.C. 103(a) as being unpatentable over Porter (U.S. Patent No. 6,473,892, hereinafter referred to as "Porter") in view of Ferrel et al. (U.S. Patent No. 5,860,073, hereinafter referred to as "Ferrel") in further view of Smith et al. (U.S. Patent No. 6,052,693, hereinafter referred to as "Smith") and in further view of Tozzoli et al. (U.S. Patent No. 6,151,588, hereinafter referred to as "Tozzoli.") The Examiner further rejected dependent claims 2 and 21 under 35 U.S.C. 103(a) as being unpatentable over Porter, in view of Ferrel et al., and in view of Smith et al. in further view of Tozzoli et al. and in further in view of Atkins (U.S. Patent No. 5,875,437, hereinafter referred to as "Atkins.") Applicants respectfully traverse each one of these rejections.

The Applicants' Remarks, set forth below, are preceded by related comments of the Examiner set forth in small indented bold-faced type.

Claim Rejections - 35 USC § 103

Claims 1, 3-20 remain rejected under 35 U.S.C. 103 (a) as being unpatentable over Porter (US 6473892, filed 31 December 1998), in view of Ferrel et al. (US 5860073, filed 17 July 1995, hereafter Ferrel), and in further view of Smith et al. (US 6052693, filed 2 July 1996, hereafter Smith), and in further view of Tozzoli et al. (US 615588, filed 9 February 1998, hereafter Tozzoli).

Applicants respectfully traverse the Examiner's rejection. The MPEP states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

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expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP § 2142.

Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness because there is no motivation to modify or combine the references' teachings and even if the references were combined, none of the prior art references, alone or in combination, describe or suggest all of the claimed limitations of at least independent claims 1 and 13.

(a) Even if the references were combined, none of the prior art references, alone or in combination, describe or suggest all of the claimed limitations of the present invention:

In the Final Office Action, the Examiner has stated:

In regard to independent claim 1, Porter discloses an object-oriented system for assembling a document (Porter abstract), the system comprising; a plurality of terms (Porter Col 5 Lines 21-25 i.e. words); a plurality of objects (Porter Col 7 Lines 19-27), and at least one of said plurality of objects including at least one of said plurality of terms (Porter Col 5 Lines 21-25 i.e. words); at least one of said conditions including at least one of said plurality of terms or a value of an object tag; and wherein the instruction comprises an action to be taken to assemble the document; and, wherein, when the condition of one of said plurality of grammar lines is true, then said instruction associated with said condition is executed thereby assembling at least a portion of said document by insertion of the object body. (Porter Col 5 Lines 21-25 i.e. words) (Porter Abstract)

Final Office Action, pg. 2-3.

Applicants respectfully disagree with the Examiner's statement that "Porter discloses an object-oriented system for assembling a document (Porter abstract), the system comprising; (...) a plurality of objects (Porter Col 7 Lines 19-27.)" Applicants' claim 1 clearly requires that each of the plurality of objects include an object tag and an object body and at least one of said plurality of objects include at least one of said plurality of terms. While the portion of the Porter patent cited by the Examiner uses the word "object," it does not disclose that the object includes an object tag and an object body and at least one of a plurality of terms. Moreover, Applicants respectfully submit that nowhere in the Porter patent is "object" used as including an object tag

and an object body and at least one of a plurality of terms. For example, in Col. 7, lines 12-13, Porter defines an object as “an input data structure” without further details:

When data entry system 18 has obtained all necessary input data from the user, it generates an input data structure or "object" 20 and passes it to an interpreter 26 which controls the assembly and printing of documents 12. Input data object 20 organizes the user input data into a set of properties or variables that interpreter 26 may consult when determining which documents 12 to produce and when determining how to adjust the content of each document 12. As it produces documents 12, interpreter 26 interprets object code contained in a set of form objects 23, a set of text objects 24 and a set of macro objects 25 produced by a compiler 22. Compiler 22 creates objects 23, 24 and 25 by compiling a source code library 28 created by programmers. Compiler 22 recompiles source code library 28 when it is necessary to update form objects 23, text objects 24 or macro objects 25 to incorporate programmer changes to source code objects in library 28.

Porter, col. 7, lines 11-27.

Applicants also respectfully disagree with the Examiner’s statement that “Porter discloses an object-oriented system (...) comprising; a plurality of terms (Porter Col 5 Lines 21-25 i.e. words.)” Applicants respectfully submit that “words” is not equivalent to “terms,” as recited in claim 1. Applicants define “term” in the Specification in the following manner:

The plurality of terms is the data underlying the document to be assembled. In the case of a financial contract, the terms would encompass the economic and non-economic terms of the transaction. Each term belongs to a specific category of information, and each category of information is represented by a trade term variable.

Specification, pg. 5, lines 3-6.

In agreement with this definition, claim 1 clearly states that the transaction file comprises “data descriptive of one or more financial transactions performed by a trading system” (emphasis added.) Thus, “words” as used by Porter is not the limitation “terms” as used by Applicants. In fact, the Examiner has admitted that “Porter does not mention a transaction file comprising a plurality of terms comprising data descriptive of one ore more financial transactions performed by a trading system” and “Porter does not mention each of said plurality of objects including an object tag and an object body.” In consequence, Applicants disagree with the Examiner’s statement that “Porter discloses (...) at least one of said plurality of objects including at least one of said plurality of terms (Porter Col 5 Lines 21-25 i.e. words.)”

Applicants respectfully submit that Applicants have found no support in the text cited by the Examiner for the Examiner’s statement that “Porter discloses (...) at least one of said conditions including at least one of said plurality of terms or a value of an object tag; and wherein the instruction comprises an action to be taken to assemble the document; and, wherein, when the condition of one of said plurality of grammar lines is true, then said instruction associated with said condition is executed thereby assembling at least a portion of said document by insertion of the object body. (Porter Col 5 Lines 21-25 i.e. words) (Porter Abstract)” (Final Office Action, pg. 2-3.)

Applicants respectfully further submit that this Examiner’s statement contradicts other statements by the Examiner in the same Final Office Action such as “Porter does not mention each of said plurality of objects including an object tag and an object body” (Final Office Action, pg. 3) and “Porter does not mention a plurality of grammar lines, each of said plurality of grammar lines including a condition and an instruction and all instructions needed for creating the document are contained in the grammar lines; when the condition of one of said plurality of grammar lines is true” (Final Office Action, pg. 3.)

Further, as Applicants have discussed earlier, Porter does not disclose “object” and “terms” as recited in Applicants’ claims.

For the foregoing reasons, Applicants respectfully request that, pursuant to 37 CFR 1.104 (c)(2), the Examiner provide a clear explanation of the pertinence of Porter as disclosing “at least one of said conditions including at least one of said plurality of terms or a value of an object tag; and wherein the instruction comprises an action to be taken to assemble the document; and, wherein, when the condition of one of said plurality of grammar lines is true, then said instruction associated with said condition is executed thereby assembling at least a portion of said document by insertion of the object body,” as claimed by the Examiner.

Porter does not mention each of said plurality of objects including an object tag and an object body. However, Ferrel mentions the story objects themselves having formatting tags (Ferrel Col 19, Lines 44-51). It would have been obvious to one of ordinary skill in the apply Ferrel to Porter, providing Porter the benefit of including object tags to identify a portion of the content and displaying the content as taught by Ferrel Col 3 Lines 32-38.

Final Office Action, pg. 3.

Applicants respectfully submit that Ferrel, as the Examiner himself states discloses “formatting tags”:

One embodiment of the present invention is a method of styling content, comprising the steps of creating a first style sheet container storing a plurality of styles, creating a second style sheet container storing a plurality of styles, creating a content container storing content and a plurality of tags, each tag identifying a portion of the content, linking the content container with the first and second style sheet containers, linking each tagged content portion to a selected one of the styles, applying each selected style to each tagged content portion, and displaying the styled content.

Ferrel, col. 3, lines 28-38.

Applicants' claims, however, do not recite "formatting tags", but "object tags" (e.g. claim 1, Fig. 3A-3C) or "grammar tags" (e.g. claim 6, Fig. 4.) Thus, Applicants respectfully submit that Ferrel does not disclose at least the limitation of claim 1 "object tag" or the limitation of claim 6 "grammar tag." Thus, Applicants further submit that the Examiner has not provided support for his statement that "[i]t would have been obvious to one of ordinary skill in the apply Ferrel to Porter, providing Porter the benefit of including object tags to identify a portion of the content and displaying the content as taught by Ferrel Col 3 Lines 32-38" (emphasis added.)

Applicants respectfully submit that even if Ferrel and Porter were combined, combining formatting tags with Porter would be of no help for one of skill in the art to arrive at Applicants' claimed invention.

Porter does not mention a plurality of grammar lines, each of said plurality of grammar lines including a condition and an instruction and all instructions needed for creating the document are contained in the grammar lines; when the condition of one of said plurality of grammar lines is true. However, Smith mentions a set of grammar rules and word lists (Smith Col 16 Lines 33-37). Smith also mentions a return of True if certain conditions are met (Smith Col 10 Lines 38-40). It would have been obvious to one of ordinary skill in the art the apply Smith to Porter, providing Porter the benefit of having grammar rules so text that have several words can appear in a single quoted string and can be divided into tokens as taught by Smith Col 19 Lines 12-18.

Final Office Action, pg. 3.

Applicants respectfully submit that the relevance of applying Smith to Porter so that Porter has "the benefit of having grammar rules so text that have several words can appear in a single quoted string and can be divided into tokens as taught by Smith" to arrive at Applicants' claimed invention is unclear to Applicants. Applicants' independent claims 1 and 13 do not recite tokens or having grammar rules so text that has several words can appear in a single quoted string and can be divided into tokens. Thus, Applicants respectfully request that the Examiner clarify his statement that "[i]t would have been obvious to one of ordinary skill in the art the apply Smith to Porter, providing Porter the benefit of having grammar rules so text that have several words can appear in a single quoted string and can be divided into tokens as taught

by Smith Col 19 Lines 12-18.” In the absence of further clarification, Applicants respectfully submit that Smith does not cure the defects of Porter, and therefore, that at least independent claims 1 and 13 are not obvious in view of Porter and in further view of Smith, even if combined with the other cited prior art references.

Porter does not mention a transaction file comprising a plurality of terms comprising data descriptive of one or more financial transactions performed by a trading system. However, Tozzoli mentions a trading system that is used for financial transactions (Tozzoli Col 4 Lines 53 through Col 7 Line 65). It would have been obvious to one of ordinary skill in the art to apply Tozzoli to Porter, providing Porter the benefit of having a financial trading system, which would assist a user in trading strategies.

Final Office Action, pg. 3-4

The applicant argues that Tozzoli fails to teach or suggest all of the claimed limitations and has not demonstrated a motivation to modify the references teachings (page 11).

Tozzoli discloses a trading system that is used for financial transactions (column 4, line 53-column 7, line 65). Tozzoli further discloses a purchase document (transaction file) containing terms comprising data descriptive of one or more financial actions performed by a trading system (column 5, lines 30-45; Here, the document includes transaction information). Tozzoli therefore teaches all the claimed limitations. Further, it would have been obvious to one of ordinary skill in the art to apply Tozzoli to Porter, providing Porter the benefit of having a financial trading system, which would assist a user in trading strategies. In addition, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Tozzoli with Porter, since it would have allowed a user to filter and generate transaction payment instructions (Tozzoli: column 5, lines 38-45.)

Final Office Action, pg. 16

Applicants respectfully submit that Tozzoli discloses “a computer system that facilitates trade in goods and services” (Tozzoli, col. 1, lines 9-10, emphasis added.) Thus, Applicants respectfully submit that one of skill in the financial arts, specifically with respect to “a system for assembling documents and, in particular, to an object-oriented document assembly system for producing financial contracts” (Specification, pg. 1, lines 3-4) in the trading of securities would unlikely resort to Tozzoli, which would provide no guidance in this field.

Nonetheless, Applicants respectfully submit that even if Tozzoli disclosed a system to facilitate securities trading, it would still be immaterial to Applicants' claimed invention, since it would provide no teaching, suggestion, or guidance in making an object-oriented document assembly system for producing financial contracts. Applicants respectfully submit that the patentability of Applicants' claimed invention must be determined, as established by the MPEP, by considering the claimed invention as a whole:

I. THE CLAIMED INVENTION AS A WHOLE MUST BE CONSIDERED

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)(...) (See also In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976.))

MPEP 2141.02 I

Therefore, the fact that one prior art reference may disclose one isolated element of the claimed invention does not render the claimed invention obvious. Moreover, as the MPEP further adds:

III. FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)(...) See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992.)

MPEP 2143.01 III

Thus, although Applicants sustain that one of skill in the art would not have resorted to Porter, Ferrel, Smith or Tozzoli for guidance in arriving at the claimed invention, Applicants

submit that even if Porter, Ferrel, Smith and Tozzoli were related to the claimed invention, and they could be combined, the mere combination of Ferrel, Smith and Tozzoli with Porter would not result in or render Applicants' claimed invention obvious.

Applicants' claimed invention as a whole offers clear advantages over the prior art as discussed in the Background section of the Specification. These advantages of the claimed invention as a whole could not be derived by the mere aggregation of the different elements the Examiner claims the cited references disclose. As claimed in the independent claims 1 and 13 as a whole, the present invention teaches a simple process for modifying a document. Documents are made up of various object bodies. If a document needs to be modified, a user only needs to change an appropriate object body. All grammar sequences that reference that object body will consequently be changed. As stated in prior responses, unlike Porter, the present invention does not require a programmer to write source code in order to modify a document. Additionally, unlike Porter, the present invention as a whole provides an elegant solution that does not require modified source code to be recompiled in order to effect the modification to the document. Porter, alone or in combination with the other cited references, simply does not describe or suggest the concepts taught by the present invention, which allow for automatic assembly of easily customizable documents.

In regard to independent claim 13, claim 13 in addition to the following reflects similar subject matter as claimed in claim 1 and is rejected along the same rationale. Further, Smith discloses testing said condition of one of said plurality of grammar lines and executing said instruction associated with said condition is true. (Smith Col 10 Lines 41-43) (Smith Col Lines 41-43). It would have been obvious to one of ordinary skill in the art to apply Smith to Porter, providing Porter the benefit of having grammar rules so text that have several words can appear in a single quoted string and can be divided into tokens and tested as taught by Smith Col 19 Lines 12-18.

Final Office Action, pg. 8-9

As stated earlier, Applicants respectfully submit that the relevance of applying Smith to Porter so that Porter has "the benefit of having grammar rules so text that have several words can appear in a single quoted string and can be divided into tokens as taught by Smith" to arrive at

Applicants' claimed invention is unclear to Applicants. Applicants' independent claims 1 and 13 do not recite tokens or having grammar rules so text has several words can appear in a single quoted string and can be divided into tokens. Thus, Applicants request that the Examiner clarify his statement that "[i]t would have been obvious to one of ordinary skill in the art the apply Smith to Porter, providing Porter the benefit of having grammar rules so text that have several words can appear in a single quoted string and can be divided into tokens as taught by Smith Col 19 Lines 12-18." Otherwise, Applicants respectfully submit that Smith does not cure the defects of Porter, and therefore that at least independent claims 1 and 13 of not obvious in view of Porter and in further view of Smith.

(b) There is no motivation to modify or combine the reference teachings:

Even if Porter, Ferrel, Smith and Tozzoli included a description of each of the claimed limitations, which they clearly do not, Applicants respectfully submit that there is no motivation for one of ordinary skill in the art to combine the cited references.

The MPEP states:

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the arts." In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998).

MPEP § 2143.01, I

None of these three possible sources have been demonstrated in the Final Office Action. Neither Porter nor Ferrel, Smith or Tozzoli provide a suggestion or motivation to combine each other. The only grounds offered by the Examiner for combining the cited references are different statements regarding what would have been obvious to one of ordinary skill in the art. A blanket statement concerning "one with ordinary skill in the art" is a highly subjective and unsubstantiated statement that does not meet the Examiner's obligation to succinctly establish a *prima facie* case of obviousness.

Thus, Applicants respectfully submit that it would not have been obvious to combine Porter with Ferrel, Smith and Tozzoli. Applicants further submit that a conclusion of the "obviousness" should be supported by some objective evidence. However, the Examiner has provided no objective support for his conclusion.

Where the Examiner's combination requires that the cited references be modified to support the Examiner's claims of obviousness, the Examiner's burden is greater and there must be some objective reason to combine the teachings of the references. See MPEP § 2143.01.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); see also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (...); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

MPEP § 2143.01, IV

Applicants respectfully submit that the Examiner has not demonstrated any of the three possible sources for a motivation to modify the Porter reference with Ferrel, Smith and Tozzoli, whether in the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the arts.

Applicants respectfully submit that this appears to be a case in which the Examiner's conclusion of "obviousness" is merely based on an application of hindsight reasoning gained by the Examiner's review of the present application. Such hindsight reasoning is impermissible.

As the MPEP notes:

The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP § 2142

*When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:(...)
(C) The references must be viewed without the benefit of impermissible hindsight vision*

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afforded by the claimed invention (...) Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986)

MPEP § 2141, II

And:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

MPEP § 2142

Furthermore, the MPEP states:

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP § 2143

Thus, the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art is unsupported by the cited references.

For at least the foregoing reasons, Applicants respectfully submit that at least independent claims 1 and 13 are not obvious in view of Porter, Ferrel, Smith and Tozzoli. Accordingly, notice to the effect that claims 1 and 13 are in condition for immediate allowance is respectfully requested.

Claims 2-12 depend from independent claim 1, and claims 14-21 depend from independent claim 13, and define further features and structure of the methods and systems. As such, these dependent claims are patentable for the reasons noted above with respect to claims 1 and 13, as well as for the additional features recited therein. Accordingly, notice to the effect that claims 2-12 and 14-21 are in condition for immediate allowance is respectfully requested.

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Applicants will not be further discuss the patentability of dependent claims 2-12 and 14-21 at this time. However, they may do so in future communications if they deem it necessary.

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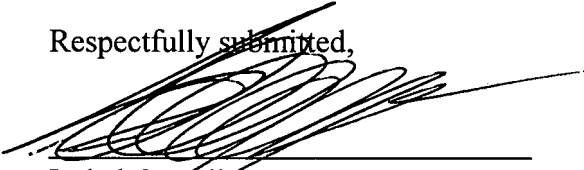
CONCLUSION

Claims 1-21 are pending and believed to be in condition for allowance. The Examiner is respectfully requested to reconsider the application at an early date with a view towards issuing a favorable action thereon. If upon the review of the application, the Examiner is unable to issue an immediate notice of allowance, he is respectfully requested to telephone the undersigned attorney at (212) 895-1376 with a view towards resolving the outstanding issues.

The Commissioner is authorized to charge and fees required in connection with this submission to Deposit Account No. 50-0521.

Respectfully submitted,

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